

### **REMARKS**

Applicant has reviewed the Office Action dated May 21, 2003 and the Advisory Action dated August 7, 2003 and the references cited therewith.

Claims 1, 11, 18, and 24 are amended. Claims 1-29 are pending in this application.

### **Examiner Interview**

Applicant wishes to thank the Examiner for courtesies extended during the telephone interview held between the Examiner and Applicant's attorney, Peter C. Maki, on October 24, 2003. During the interview, claim 1 and the Doan reference were discussed. However, no agreement was reached regarding the present application.

### **§103 Rejection of the Claims**

In the Office Action, claims 1 – 4, 6 – 20, 22, 24, 25, 28 and 29 were rejected under 35 USC § 103(a) as being unpatentable over Helland et al. (U.S. Patent No. 5,545,201) in view of Doan (U.S. Patent No. 5,425,755).

### **Claims 1-4 and 6-10**

Applicant has amended claim 1 to better describe the subject matter recited in the claim. Applicant believes claim is not obviousness in view of the cited references since, even if combined, the cited references fail to teach or suggest all of the elements of applicant's claimed invention. Moreover, there is no suggestion or motivation in the art to combine the cited references. For instance, even if combined, the combination does not include a lead assembly including a lead body including two or more conductors disposed therein, the second conductor disposed within the first conductor, "the second conductor including one or more filars having an outer filar surface having an insulative coating surrounding the outer filar surface such that a cross-section of the outer filar surface is surrounded by an insulative coating," as recited in claim 1. In contrast, Helland does not discuss such subject matter and the conductor of Doan includes a coating on the outer surface of a coiled conductor, but the coating does not surround a cross section of the outer filar surface, as claimed.

Moreover, Applicant traverses the rejection since there is no suggestion to combine the cited references. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's

disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143.

Applicant cannot find in either disclosure any teaching or suggestion to combine the two references to form the subject matter as claimed, and the Examiner has not provided a sufficient motivation for making the alleged combination. Reconsideration and allowance is respectfully requested.

Claims 2-4 and 6-10 include each limitation of their parent claim and are therefore also not obvious over the cited references. Reconsideration and allowance is respectfully requested.

#### Claims 11-17

Applicant believes claim 11 is not obvious in view of the cited references since, even if combined, the combination would not include each limitation recited in the claim. For instance, a lead assembly including a coating of insulation surrounding an outer filar surface of one or more filars of the first conductor or the second conductor “such that a cross-section of the outer filar surface of the first conductor or the second conductor is surrounded by an insulative coating.” Again, neither of the cited references includes such subject matter, and the above discussion is incorporated herein by reference.

Claims 12-17 include each limitation of their parent claim and are therefore also not obvious over the cited references. Reconsideration and allowance is respectfully requested.

#### Claims 18-20 and 22

Applicant believes claim 18 is not obvious in view of the cited references since, even if combined, the combination would not include each limitation recited in the claim. For instance, a method including providing a second conductor having a coiled configuration having a second outer coil diameter, and the second conductor having a second outer filar diameter, and “providing insulation surrounding the second outer filar diameter such that a cross-section of the outer filar diameter is surrounded by an insulative coating,” as recited in claim 18. Again, neither of the cited references includes such subject matter, and the above discussion is incorporated herein by reference.

Claims 19, 20, and 22 include each limitation of their parent claim and are therefore also not obvious over the cited references. Reconsideration and allowance is respectfully requested.

Claims 24, 25, 28 and 29

Applicant believes claim 24 is not obvious in view of the cited references since, even if combined, the combination would not include each limitation recited in the claim. For instance, a method including providing a second conductor having a coiled configuration having a second outer coil diameter, and “the second conductor having a second outer filar diameter surrounded by an insulative coating such that a cross-section of the second outer filar diameter is surrounded by an insulative coating,” as recited in claim 24. Again, neither of the cited references includes such subject matter, and the above discussion is incorporated herein by reference.

Claims 25, 28, and 29 include each limitation of their parent claim and are therefore also not obvious over the cited references. Reconsideration and allowance is respectfully requested.

In the Office Action, claims 5, 21, 23, 26 and 27 were rejected under 35 USC § 103(a) as being unpatentable over Helland et al. (U.S. Patent No. 5,545,201) in view of Doan (U.S. Patent No. 5,425,755) and further in view of Altman et al. (U.S. Patent No. 5,845,396).

Claims 5, 21, 23, 26, and 27 depend from their respective parent claims and are not obvious for the reasons given above.

Also, Altman et al. discuss a technique to manufacture a co-radial coiled lead without having the coils unwind during manufacture. (Abstract, Altman et al.). This leads away from parent claims 1, 18, and 24 which recite non co-radial first and second conductors.

Moreover, regarding claims 5, 21, 23, 26, and 27, Applicant traverses the obvious-design-choice rationale of the Examiner. In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.

*Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985); MPEP § 2141.02. Here, the Examiner has focused on the differences between the claims and the cited references and has not provided a sufficient motivation for making the alleged combinations. Reconsideration and allowance is respectfully requested.

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 – EXPEDITED PROCEDURE

Serial Number: 09/870376

Filing Date: May 30, 2001

Title: EXTENDABLE/RETRACTABLE LEAD HAVING DOWNSIZED LEAD BODY

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Dkt: 279.368US1

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 359-3267 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop RCE, Commissioner of Patents, P.O.Box 1450, Alexandria, VA 22313-1450, on this 20 day of November, 2003

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